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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,228	11/12/2003	Hiroki Yamamoto	2038-304	3549
22429 7590 08/22/2008 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314				
EXAMINER				
MCLELLAND, KIMBERLY KEIL				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
08/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/705,228

Applicant(s)

YAMAMOTO ET AL.

Examiner

KIMBERLY K. MCCLELLAND

Art Unit

1791

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3, 6, 7, 9, 10, 12-19, 22, 23 and 25-27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791

/Kimberly K McClelland/
Examiner, Art Unit 1791

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 8/13/08 have been fully considered but they are not persuasive.

As to applicant's argument that Blenke teaches away from the arrangement of Syndikus, examiner disagrees. Firstly, column 1, lines 40-46 refers to conventional elastic placing methods, not the actual invention of Syndikus. This citation specifically teaches away from complicated web paths, not the use of a motor having a rotary shaft and an arm connected directly to the rotary shaft. While Blenke specifically teaches away from complicated web paths, this teaching has nothing to with the improved design of Syndikus. Syndikus specifically discloses such an arrangement improves control over oscillating movements. Therefore, such a combination would be seen as preferable over the indirect control of the pivoting arm in Blenke. One of ordinary skill in the art would recognize the directly attached arm of Syndikus is directly connected to the motor, and therefore more responsive to changes in direction and velocity versus the indirectly attached arm of Blenke. This serves as the necessary motivation to obtain the current invention. Furthermore, the simple substitution of one known element (the elongated arm of Syndikus) for another (the oscillating arrangement of Blenke) would achieve the predictable result of providing improved arm control during oscillations. Consequently, Blenke is not found to teach away from the arrangement of Syndikus. With respect to applicant's argument against the combination of Hermann with Blenke and Syndikus, because Blenke offers a different arrangement than the device of Hermann, this argument is not persuasive. Firstly, the current rejection of claims 1-4, 6-7, 9-19, and 22-27 is one of obviousness under 35 U.S.C. 103(a), not anticipation under 35 U.S.C. 102(b). Also, it is generally held that rearrangement of parts that does not otherwise modify the operation of the device is found to be obvious (In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)). Hermann's disclosure of a different arrangement of parts could easily be combined with the disclosure of Blenke to allow for increased process speeds (column 1, lines 29-31). While the arrangement of Hermann is different than the device of Blenke, it is this teaching of a new arrangement which is relied upon to suggest obviousness. Such a modification would not alter the operation of the device, only the orientation of its components. Consequently, the orientation of the parts is not considered to significantly alter the operation of a device.

With respect to applicant's argument that there is no reasonable expectation of success in the combination of Uchida with Blenke, examiner disagrees. Blenke specifically discloses any material known in the art may be used at the placement head of the apparatus (column 5, lines 47-50). Fiber-resin composites are a well-known substance that is commonly used to replace wooden and metal articles due to their low cost, increased strength, and flexibility. They are used in a wide range of industries. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a well-known material based on its low cost, high strength, and low weight as the material in the oscillating arm of Blenke. The success for these composites in a variety of industries yields a reasonable expectation of success as an oscillating arm in the current device. In response to applicant's argument that the use of the sheet material in Uchida would not function properly in the device of Blenke, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Examiner is not suggesting the sheet material of Uchida should be incorporated into the device of Blenke, but that such fiber-resin composites are well known in the art for their increased strength and low cost. Blenke's disclosure of any material known in the art serves as evidence of a reasonable expectation of success for the combination. As to applicant's arguments regarding claims 22-23, these arguments are not persuasive. One of ordinary skill in the art would recognize the specific gravity and bending modulus of the oscillating arm may be varied depending on the size and shape of the desired curvilinear path of the elastic members and desired mechanical properties of the oscillating arm. Altering these properties of the arm would enable one to change the pattern profile and produce the desired strength and flexibility for adequate operational parameters. Therefore, the optimal values for these properties are obtainable through routine experimentation in the absence of a showing of criticality, based on the preferred elastic pattern and mechanical properties of the oscillating arm.

Continuation of 13. Other: Newly amended claims 9, 13, 15-19, and 22 would be rejected under 35 U.S.C. 103 (a) over previously cited Blenke in view of Syndikus, Uchida, and Cordeiro under the same grounds as previously stated. Claims 1-2, 6-7, 12, 14, and 23 would be rejected under 35 U.S.C. 103 (a) over previously cited Blenke in view of Syndikus, Uchida, Cordeiro, and Hermann as previously stated. Claim 3 would be rejected over Blenke in view of Syndikus, Uchida, Cordeiro, Hermann, and further in view of Liu as previously stated. Claim 10 would be rejected over Blenke in view of Syndikus, Uchida, Cordeiro, and further in view of Liu. Newly amended claims 9, 13, 15-19, 22, and 27 are also rejected over previously cited Blenke in view of Syndikus, Heikkila, and Cordeiro. Claims 1-2, 6-7, 12, 14, 23, and 25-26 would be rejected over Blenke in view of Syndikus, Heikkila, Cordeiro, and further in view of Hermann. Claim 3 would be rejected over Blenke in view of Syndikus, Heikkila, Cordeiro, Hermann, and further in view of Liu. Claim 10 would be rejected over Blenke in view of Syndikus, Heikkila, Cordeiro and further in view of Liu. Applicant's incorporation of dependent claim 24 into independent claims 1 and 15 results in the inclusion Cordeiro in the current rejection. Cordeiro is relied upon to disclose a known angular acceleration rate for servomotors similar to those discussed in Blenke. Uchida and Heikkila each teach carbon fiber resin composites. The remaining portions of the rejection remain unchanged.